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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/029,386

04/03/2002

Sharron Gaynor Penn

PB-01106

4235

22840 7590 06/02/2005

AMERSHAM BIOSCIENCES
PATENT DEPARTMENT
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EXAMINER

BORIN, MICHAEL L

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,386

Applicant(s)

PENN ET AL.

Examiner

Michael Borin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36,38-115,128 and 129 is/are pending in the application.
- 4a) Of the above claim(s) 1-35 and 41-109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36,38-40,110-115,128 and 129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/03/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Examiner of record has been changed. Please address subsequent correspondence to Examiner M. Borin, Art Unit 1631.

Status of Claims

Amendment filed 03/02/2005 is acknowledged.

Claims 1-36,38-115,128,129 are pending. Claims 1-35,41-109 remain withdrawn from consideration. Claims 36,38-40,110-115,128,129 are under examination.

Rejections and/or objections not reiterated from previous Office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 U.S.C. § 101/ 112-1

Claims 36,38-40,110-115,128,129 are rejected under 35 U.S.C. § 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. The rejection is maintained for the reasons of record.

Applicant submits that specific expression of SEQ ID No: 13,975 is disclosed in specification and refers to Tables 4,7-11. Table 4 does not provide any information confirming specific expression of SEQ ID No: 13,975, while Tables 7-11 indicate that SEQ ID No: 13,975 is expressed somewhere (the abbreviations are not translated, so the meaning of the information is not possible to discern), but provide no indication on

how specific the expression is. Applicant is invited to provide convincing evidence confirming specific expression of SEQ ID No: 13,975.

Consequently, the rejection under 35 U.S.C. 112, first paragraph, is also maintained for the reasons of record.

Claim Rejections - 35 U.S.C. § 112-1 (NEW MATTER)

Claims 110-115,129 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The rejection is maintained for the reasons of record.

With respect to claims 110-111, applicant points at tables 4 and 7; however, as addressed in the previous rejection, Table 4 does not provide any information confirming specific expression of SEQ ID No: 13,975, while Tables 7-11 indicate that SEQ ID No: 13,975 is expressed somewhere - the abbreviations are not translated, so the meaning of the information is not possible to discern.

With respect to claims 112-115 applicant states that "the same is true for claims 112-115". It is not clear what "the same" is meant.

With respect to claim 129, applicant points at p. 38, lines 8-9; however, said section states that only at least about 50% of the probes lack homopolymeric

regions – nowhere specification teaches that each and every probe, SEQ ID No: 13,975 in particular, lacks homopolymeric stretches of A or T.

Conclusion.

No claims are allowed

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D, can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/029,386
Art Unit: 1631

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Michael Borin, Ph.D.

Primary Examiner

Art Unit 1631

A handwritten signature in black ink, appearing to read 'Michael Borin', with a long, sweeping horizontal line extending to the right.

mlb